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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,938	10/14/2003	Ronald W. Hartgrove	11149.0029.DVUS01	7909

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EXAMINER	
RODRIGUEZ, RUTH C	

ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary

Application No.	**Applicant(s)**	
10/684,938	HARTGROVE, RONALD W.	
Examiner	**Art Unit**	
Ruth C Rodriguez	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-6,10,11,13 and 21-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *24 and 26* is/are allowed.

6)☒ Claim(s) *2-6,10,11,13,21-23,25 and 27-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 2, 4-6, 10, 11, 13, 21-23, 25, 27 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 5,228,317) in view of Mangano.

Hendricks discloses a jewelry article comprising a setting (20,21,22), a first body portion (23) and a second body portion (27). The setting has a mounting portion (22). The first body portion has a holding portion (35). The holding portion holds the mounting portion except from at least one direction (Fig. 6). The second body portion couples with the first body portion (Figs. 1-11). The second body portion holds the mounting portion from the at least one direction when coupled to the first body portion when the finger of the user is inserted into the article of jewelry (Figs. 4 and 11). The body portions are separable from one another in the at least one direction to break the coupling between the body portions (Figs. 2, 3, 5, 6, 9 and 10). Hendrick fails to provide a reliable means to releasably retain the first body portion engaged with the second body portion while holding the mounting portion when the article of jewelry is not being worn. As mentioned above in paragraph 2, Mangano teaches a jewelry article having first and second body portions where the second body portion holds the mounting portion from the at least one direction when magnetically coupled to the first body portion. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant invention to have the first and second body portions magnetically coupled as taught by Mangano in the jewelry article disclosed by Hendricks. Doing so, provides a secure connection between the first body portion and the second portion to retain the setting. One would have been motivated to make such a combination because the value of the jewels used for the setting is considerable and providing reliable means to maintain the first and second body portions in engagement with the setting in order to prevent accidental loss of the setting would have been obtained, as taught by Mangano.

Mangano teaches that at least one of the body portions comprises a magnetic element (32,34) disposed thereon.

Hendricks discloses that the first and second body portions are substantially identical (Figs. 5-11).

The first and second body portions taught by Mangano are magnetically coupled together to form a ring, a bracelet, an earring, a chocker, a bezel, a pendant (40,50) or a broach. While Hendricks teaches that the first and second body portion are coupled together to form a ring (Figs. 1-11), a bracelet, an earring, a chocker, a bezel, a pendant or a broach.

Mangano teaches that the means for magnetically coupling the first and second means comprises at least one magnet (32,34) (Figs. 2A-2C and 4A-4C).

Hendricks discloses that:

- The mounting portion of the setting disclosed by Hendricks includes a first rectilinear structure (22) and the holding portion of the first body portion includes a second rectilinear structure (39) that is substantially complementary to the first rectilinear structure (C. 3, L. 4-21 and Figs. 1-3, 6, 7, 10 and 11). The first and second rectilinear structures mate with one another in the at least one direction when mounting the setting on the first body portion and hold the setting except from the at least one direction (Figs. 1-11).
- The second rectilinear structure defines a negative are in the first body portion (Figs. 1-11).

Hendricks discloses that the first body portion includes a first half of a ring having a first surface (Figs. 1-11). The holding portion comprises a negative area defined in the first surface in which the mounting portion of the setting positions (Figs. 1-11). The second body includes a second half of the ring and has a second surface coupled to the first surface. Hendricks fails to disclose that the second surface is magnetically coupled to the first surface. However, as recited above, Hendricks and Mangano can be combined to magnetically couple the first body portion and second body portion by providing a reliable means to keep the first body portion secured to the second body portion when the ring is not being used.

Hendricks discloses a jewelry article comprising a setting (20,21,22), first means for holding the setting except from at least one direction (23), second means for holding the setting from at least one direction (27), means for coupling the first and second means for holding the setting (29) and means for separating the first and second means in the at least one direction to break the coupling between the first and second means (rotating 27 away from 23). Hendrick fails to provide a reliable means to releasably retain the first body portion engaged with the second body portion while holding the mounting portion when the article of jewelry is not being worn. As mentioned above in paragraph 2, Mangano teaches a jewelry article having first and second means where the second means holds the setting from the at least one direction when magnetically coupled to the first means. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant invention to have the first and second means magnetically coupled as taught by Mangano in the jewelry article disclosed by Hendricks. Doing so, provides a secure connection between the first body portion and the second portion to retain the setting. One would have been motivated to make such a combination because the value of the jewels used for the setting is considerable and providing reliable means to maintain the first and second body portions in engagement with the setting in order to prevent accidental loss of the setting would have been obtained, as taught by Mangano.

Hendricks also discloses that:

- The jewelry article further comprises mans for preventing tilting of the setting in the magnetically coupled first and second means (C. 3, L. 4-21).
- The means for separating the first and second means comprises means for pulling apart the first and second means (by rotating 27 away from 23).

Mangano teaches that the means for magnetically coupling the first and second means comprises at least one magnet (32,34).

Hendricks discloses a ring comprising an interchangeable setting (20,21,22) (C. 1, L. 6 and 7), a first half of the ring 23) and a second half of the ring (27). The first half of the ring has a first inner surface (39). The setting mounts on the first half of the ring such that the first half of the ring holds the setting except from one direction (Figs. 3, 6 and 10). The second half has a second inner surface (Figs. 1-11). The second surface couples to the first inner surface of the first half of the ring such that the second half of the ring holds the setting from the one direction (Figs. 1-11). The coupled halves of the ring are separable from one another in one direction to break the coupling between the halves of the ring and to interchange the setting (by rotating 27) (Figs. 1-11). Hendrick fails to provide a reliable means to releasably retain the first body portion engaged with the second body portion while holding the mounting portion when the article of jewelry is not being worn. As mentioned above in paragraph 2, Mangano teaches a jewelry article having first and second halves where the second half holds the mounting portion from the at least one direction when magnetically coupled to the first half. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant invention to have the first and second halves magnetically coupled as taught by Mangano in the jewelry article disclosed by Hendricks. Doing so, provides a secure connection between the first half and the second half to retain the setting. One would have been motivated to make such a combination because the value of the jewels used for the setting is considerable and providing reliable means to maintain the first and second body portions in engagement with the setting in order to prevent accidental loss of the setting would have been obtained, as taught by Mangano.

Hendricks also discloses that:

- The first and second body halves of the ring are substantially identical (Figs. 5-11).
- The first inner surface includes a first rectilinear structure (39) and the setting includes a second rectilinear structure (22) that is substantially complementary to the first rectilinear structure (C. 3, L. 4-21 and Figs. 1-3, 6, 7, 10 and 11). The first and second rectilinear structures mate with one another in the one direction when mounting the setting on the first half of the ring and hold the setting except from the one direction (Figs. 1-11).
- The second rectilinear structure defines a negative are in the first body portion (Figs. 1-11).

The setting disclosed by Hendricks includes a mounting portion engaged by portions of the first and second surfaces and includes a decorative portion (20) extending beyond the coupled halves of the ring. Although Hendricks fails to disclose that the halves are magnetically coupled, as recited above, a combination of Hendricks and Mangano can be made to magnetically couple the first half and second half by providing a reliable means to keep the first half secured to the second half when the ring is not being used.

3. Claims 3 and 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrick in view of Mangano as applied to claim 6 and 27 above, and further in view of Indiveri et al. (US 6,305,192 B1).

Hendricks and Mangano were combined in paragraph 6 to reject the limitations of claim 6. Mangano teaches the use of a magnetic element to keep the first body portion magnetically coupled to the second body portion but fails to disclose that the magnetic element is a rare earth element. However, Indiveri demonstrates an article of jewelry (100) having a pair of magnetic elements (106,108). The magnetic element being used is preferably a rare earth magnet (C. 4, L. 33-36). The rare earth magnets provide the advantage of being light weight in comparison to the force of their magnetic attraction (C. 4, L. 33-36). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a rare earth magnet used in jewelry as demonstrated by Indiveri in the jewelry article disclosed by Hendricks and modified by Mangano. Doing so, provides a lightweight in comparison to the force of their magnetic attraction. One would have been motivated to make such a combination because having a lightweight jewelry article is highly sought in the jewelry industry because the jewelry users prefer jewelry article of lighter weight and a reduction in weight of the jewelry article would have been obtained, as demonstrated by Indiveri

The same rejection of claim 3 can be applied to claim 28 since all the limitations of claim 27 were addressed above in paragraph 6 and the same reasons for the combination of claim 3 apply to claim 28.

Allowable Subject Matter

4. Claims 24 and 26 are allowed.

Response to Arguments

5. Applicant's arguments filed 13 July 2004 have been fully considered but they are not persuasive.

6. In response to applicant's argument that Hendricks fails to disclose "the first and second body portions are separable from one another in the at least one direction to break the magnetic coupling between the body portions", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case although this limitation is considered an intended use limitation, Hendricks also is capable of meeting this limitation because the claim does not exclude the rotation of the first and second body portions about the pin as the means to obtain the separation the first and second body portions in the at least one direction and to break the magnetic coupling between the body portions. Therefore, Hendricks does anticipate this limitation

and the claims will remain rejected unless the claims are modified to positively recited a limitation that will exclude the rotation of the first and second body portions as the means to separate the first and second body portions in the at least one direction.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Elliot (US 899,296), Eberle et al. (US 3,115,758), Estrin et al. (US 3,307,375) and Guerrero et al. (US 4,416,074) are cited to show state of the art with respect to jewelry having mechanical connection that could be replaced with magnetic connections to obtain the claimed invention.

Beck (US 3,639,949), Nagano (US 6,101,843), Hoffman (US 6,594,871 B1), Tschetter (US 6,688,139 B2) and Marandola, Jr. (US 2002/0139142 A1) are cited to show state of the art with respect to jewelry using a magnetic connection.

Hernandez (US 4,783,974), Green (US 6,470,708 B1) and Plumly (US 6,718,797 B2) are cited to show state of the art with respect to having jewelry using mechanical connections or magnetic connections interchangeably.

Schlinger et al. (US 5,806,346) is cited to show state of the art with respect to having jewelry with permanent magnets selected from rare earth magnets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Submissions of your responses by facsimile transmission are encouraged. Technology center 3600's facsimile number for before and final communications is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may also be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

rcr
October 15, 2004

ROBERT J. SANDY
PRIMARY EXAMINER